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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,828	02/12/2004	Henrik Clausen	20406/1202533-US	5885
7278	7590	06/04/2007	EXAMINER	
DARBY & DARBY P.C.			RAO, MANJUNATH N	
P.O. BOX 770			ART UNIT	
Church Street Station			PAPER NUMBER	
New York, NY 10008-0770			1652	
			MAIL DATE	DELIVERY MODE
			06/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No.	Applicant(s)	
	10/777,828	CLAUSEN ET AL.	
	Examiner	Art Unit	
	Manjunath N. Rao, Ph.D.	1652	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 04 May 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 38 and 41-43.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

Manjunath N. Rao, Ph.D.  
Primary Examiner  
Art Unit: 1652

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*Advisory Action*

Claims 38, 41-42 are now currently pending in this application.

Applicant's request for reconsideration filed on 5-4-07 has been considered but NOT ENTERED, as it raises new issues and requires the Examiner to institute new rejections. The amendment has not been entered for the following reasons;

In response to the previous Office action, applicants have amended the claims. While the amendments do overcome the previous rejections under 35 U.S.C. 112, 1<sup>st</sup> paragraph, it raises a new issue under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. The current amendment to claims 38 and 42 line 9-10 and 8-9 respectively, recites "and wherein said probe hybridizes to  $\beta$ 3Gal-T5 and not to  $\beta$ 3Gal-T1,  $\beta$ 3Gal-T2,  $\beta$ 3Gal-T3, or  $\beta$ 3Gal-T4 family members". It appears that applicant meant to recite "wherein said probe hybridizes to the polynucleotide encoding a  $\beta$ 3Gal-T5 and not to polynucleotides encoding  $\beta$ 3Gal-T1,  $\beta$ 3Gal-T2,  $\beta$ 3Gal-T3, or  $\beta$ 3Gal-T4 family members". Without the word "polynucleotide" in the recitation, the amendment does not make any scientific sense, since polynucleotides do not hybridize to polypeptides sequences. Therefore entering the amendment as is would require the Examiner to issue to a new rejection.

Furthermore, it is noted that applicants have filed a Terminal Disclaimer in order to overcome the rejection under Double Patenting rules. However, Examiner continues to maintain the rejection under Double Patenting rules, since the TD filed has been found to be defective and has not been approved. The TD filed disclaims only a 50% interest by one of the inventor as opposed to disclaiming 100% interest by both the inventors. Examiner urges applicants to file another TD which disclaims 100% interest in the recited patent

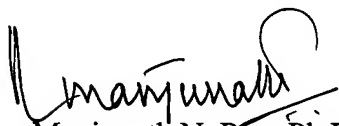
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In view of the non-entry of the current amendment, all previous rejections are maintained for reasons of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Manjunath N. Rao, Ph.D.  
Primary Examiner  
Art Unit 1652

May 31, 2007